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**REMARKS**

This paper is responsive to the Office Action and examiner interview identified above and below, and in any other manner indicated below.

**EXAMINER INTERVIEW ACKNOWLEDGED**

This paper is responsive to the examiner interview conducted 15 December 2005, by and between (as indicated on the Interview Summary document) assigned Examiner Trang U. Tran, Applicant's foreign representatives Masanobu Sakata and Yuzo Okano, and attorney Paul J. Skwierawski, in the present application. More particularly, any foregoing amendments may include amendments discussed during, or resultant from, the examiner interview, and the following includes a reiteration of discussions/arguments had during the examiner interview.

**EXTENSIVE PROSECUTION NOTED**

Applicant and the undersigned respectfully note the extensive prosecution which has been conducted to-date in the present application, i.e., numerous pre-interview Office Actions, an examiner interview where the prior art (e.g., Lawler et al. and Alten et al.) was indicated as having been overcome, and then subsequent Office Actions (instead of allowance). It is respectfully noted that the present application was filed in 1999, and already has had 9+ Office Actions on the merits, ...in short, it is respectfully submitted that there has been an excessive number of Office Actions issued within the present application. Applicant and the undersigned

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would gratefully appreciate any consideration or guidance from the Examiner to help move the present application quickly to allowance.

### PENDING CLAIMS

Claims 42-65 were pending for consideration and examination in this application, and at entry of this paper, Claims 42-65 remain pending for further consideration and examination in this application.

### REJECTION UNDER 35 USC §103

The continued 35 USC §103 rejection of Claims 42-65 as being unpatentable over Lawler *et al.* (U.S. Patent 5,585,838) in view of Yoshimitsu *et al.* (JP 02-043674), Alten *et al.* (U.S. Patent 5,781,246), and further in view of the VideoGuide User's Manual, Part # 030-10011, Revision 1.0, 1995 (page 12), is respectfully traversed. Applicant respectfully submits the following to traverse such rejection.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

Applicant's independent claims recite, for example (independent Claim 42), a digital broadcasting RECEIVER (e.g., a set-top box) including "an omission display controller which is located in the receiver and compares a decoded character data amount with a data amount which can be displayed in a first

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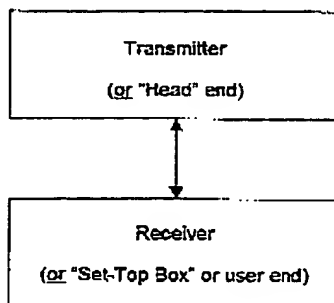
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prescribed zone to determine whether a number of characters in the received character information of the particular extended program is larger than a number of characters which can be displayed in the first prescribed zone indicative of a prescribed time period of the grid, and omits a part of a character information of a particular extended program when a number of characters in the received character information of the particular extended program is larger than a number of characters which can be displayed in a first prescribed zone indicative of a prescribed time period of the grid, at least when the particular extended program exceeds the prescribed time period of the first prescribed zone of the grid". One very important aspect to note, is that with Applicant's invention, the "comparing/omitting" takes place at a RECEIVER (e.g., set-top box or user) end.

More particularly, a multi-media transmitter/receiver system may be described generically as having a transmitter (or "head" end) side and a receiver (or "set-top box" or user end side) as shown by the following illustration.



Again, with Applicant's invention, the "comparing/omitting" takes place at a RECEIVER (e.g., set-top box or user) end. In contrast to Applicant's

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invention, the main storage and processing (e.g., comparing) of video or character information of programs conventionally (at the time of Applicant's invention) was done within the transmitter end. The conventional arrangement was advantageous in that storing within the transmitter end allowed a smaller memory to be used for the receiver end (thereby reducing receiver manufacturing/purchase costs), and processing within the transmitter end allowed minimal data to be transmitted across to the receiver (thereby minimizing use of precious bandwidth).

The cited Alten et al. reference is an example of such conventional "transmitter" arrangement. More particularly, Alten et al.'s column 30, line 42, through column 31, line 13, states (in relevant part),

One of the novel features of the disclosed invention is the textfit system. The preferred embodiment of the textfit system includes an interactive computer program used to edit the program listings data BEFORE it is transmitted to the user and stored in memory. ...the data processor first analyses the listings data to determine what grid size listings are needed for each title. Thus, a two hour movie could require four different edited titles to fit into each of the four different size grid cells (30, 60, 90, 120 minutes). ...The editor is then queried to alter the title so that it will fit in the allotted space. If the title must be edited for more than one cell size, the editor is queried to edit each of them separately.

Thus, Alten et al. teaches the prevalent standard in the art to perform pre-truncating of titles BEFORE transmission to the receivers, so as to minimize transmission bandwidth and receiver memory storage.

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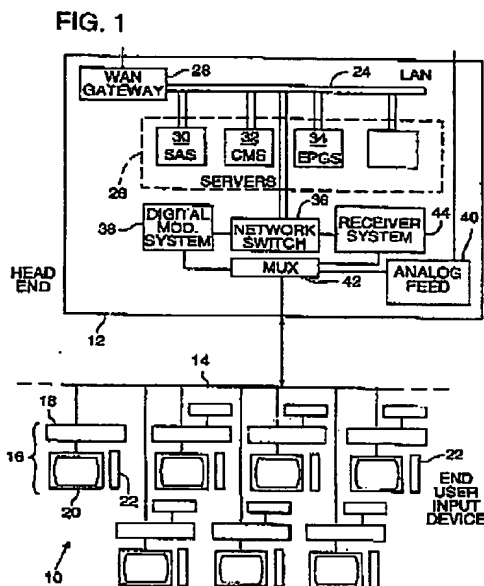
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Turning now to rebuttal of the primary, i.e., Lawler *et al.*, reference, such reference has a transmitter (or "head" end) side and a receiver (or "set-top box" or user end side as shown by Lawler *et al.*'s FIG. 1 as follows:



Office Action comments appear to contend that Lawler *et al.*'s FIGS. 1-2 interactive controller 18 (at the receiver end) itself performs operations like Applicant's operations, i.e., "omits a part of a character information of a particular extended program when a number of characters in the received character information of the particular extended program is larger than a number of characters which can be displayed in a first prescribed zone indicative of a prescribed time period of the grid." The 15 July 2005 Office Action comments (page 3) state:

...Lawler *et al.* shows in Fig. 3 'Trailside: Make You...' ...In order to show 'Trailside: Make You ...', the number of characters in the received character information of the particular extended program is compared with the number of characters which can be displayed in a first prescribed zone indicative of a prescribed time period of the grid and the part of a character information of a particular extended program is omitted when a number of

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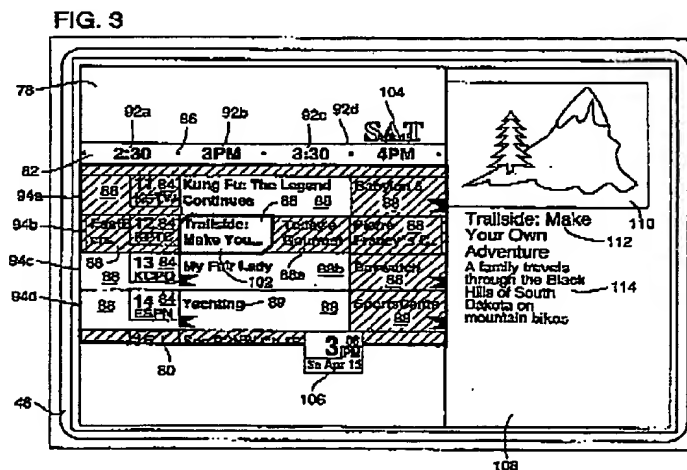
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characters in the received character information of the particular extended program is larger than a number of characters which can be displayed in a first prescribed zone indicative of a prescribed time period of the grid. Therefore, the claimed comparing process which compares a number of characters of an extended program information with the number of characters which can be displayed within a first prescribed zone is inherent characteristic of Lawler et al...

**It is respectfully submitted that strong traversal is appropriate, because the Examiner's assumption IS WRONG and Lawler et al. teaches otherwise.**

More particularly, Lawler et al. analysis/disclosure is as follows: Lawler et al.'s "interactive station controller 18" (FIGS. 1-2) is (at best) vaguely similar to Applicant's "receiver" (e.g., set-top box). Lawler et al.'s interactive station controller 18 cooperates with Lawler et al.'s "head end 12" (FIG. 1) which is located at the service provider's remote location (i.e., remote from the end user's and interactive station controller 18's location). One of the items that the interactive station controller 18 and head end 12 cooperate about is program information.

Regarding a program grid display, Lawler et al.'s FIG. 3 shows a programming grid such as:



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Of special interest, a presently-selected (i.e., highlighted) "focus frame 102" grid-block includes a truncated title "Trailside: Make You ...", while a "program summary panel 108" includes the full title of the presently selected program block, i.e., "Trailside: Make Your Own Adventure ...". That is, the program summary panel 108 is used to provide a user with more detailed information about a selected program. As the focus frame 102 is moved to any differing grid-block, the program summary panel 108 is updated to provide additional information about the program of the newly-identified grid-block.

Under the Examiner's inherency assertion, Lawler *et al.*'s interactive station controller (i.e., "receiver") must initially receive the full title, i.e., "Trailside: Make Your Own Adventure ..." and store it into memory somewhere in the receiver end, and then must itself compare/omit characters to achieve the truncated block reading "Trailside: Make You ...". However, IF the Lawler *et al.* arrangement did initially receive and store the full title, then at a later time when a user subsequently selected (e.g., highlighted) the truncated "Trailside: Make You ..." block, the Lawler *et al.* interactive station controller 18 (i.e., "receiver") should UNILATERALLY (i.e., BY ITSELF) be able to retrieve the same from its own "receiver" memory and then immediately display the full title, i.e., "Trailside: Make Your Own Adventure ..." within the program summary panel 108. That is, given that transmission bandwidth was a scarce commodity, Lawler *et al.*'s receiver would have saved the full title in memory for any anticipated later use.

However, Lawler *et al.*'s column 10, lines 20-52 discloses that Lawler *et al.*'s arrangement DID NOT have the full title data stored within receiver memory. That is, Lawler *et al.*'s column 10, lines 20-52 text reads:

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The program summary panel 108 can be used to provide a user with more detailed information about a selected program. Preferably the program identified by the focus frame 102 is the subject of the program summary panel 108. As the focus frame 102 is moved, the program summary panel 108 is updated to provide additional information about the newly identified program. ...The program information in the illustrated program summary panel 108 is obtained UPON REQUEST of the interactive station controller 18 from the head end 12.

That is, it is clear from Lawler et al's explicit disclosure, that Lawler et al's interactive station controller 18 DOES NOT INITIALLY RECEIVE THE FULL TITLE (OR OTHER DETAILED INFORMATION), and Instead, MUST SPECIFICALLY REQUEST SUCH DETAILED INFORMATION ONLY WHEN THE PROGRAM IS SELECTED IN A FOCUS FRAME 102.

It logically follows that Lawler et al's interactive station controller (like Alten et al. arrangement) INITIALLY ONLY RECIEVES THE TRUNCATED TITLE FROM THE HEAD END 12 FOR THE BLOCKS FOR ITS PROGRAMMING GRID 80. This totally agrees with the standard in the art at the time of Applicant's invention, which was to only provide truncated-information blocks to receivers to minimize (save precious) transmission bandwidth. In short, the Lawler et al. description tends to show that Lawler et al. (like Alten et al.) followed such convention.

Thus, despite the Examiner's (i.e., "inherency") speculation, it is respectfully submitted that Lawler et al. does not operate as the Examiner speculated, i.e., Lawler et al. instead teaches the prevalent standard in the art to perform pre-truncating of titles BEFORE transmission to the receivers, and thus TEACHES AWAY from Applicant's invention.

Beyond the above arguments, it is respectfully submitted that the Examiner's usage of "inherency" is improper in the present situation. More particularly,



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regarding proper usage of inherency, it is well settled under U.S. patent law that to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999). Moreover, the Court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In the present situation, comparison/omission to obtain truncated titles for Lawler *et al.*'s program tiles 88 is not "necessarily" present (i.e., performed) within Lawler *et al.*'s "receiver". In fact, the state of the art and Lawler's own disclosure tend to show that comparison/omission within Lawler *et al.* occurs differently, i.e., within Lawler *et al.*'s "transmitter" or head end.

In continuing rebuttal of the other applied art, Yoshimitsu *et al.* appears to have been applied for teachings that when a number of characters of title data exceeds a predetermined value, the last numeric character of the title data is omitted and "..." is displayed. Even assuming *arguendo* that Yoshimitsu *et al.* does teach truncating and substituting "..." characters, Yoshimitsu *et al.* does not cure the major deficiency mentioned above with respect to the Lawler *et al.* and Alten *et al.* references, i.e., Yoshimitsu *et al.* also does not teach receiving program information at a receiver and then performing comparison/omission at the receiver end to obtain truncated titles to fit a program grid.

That is, from the limited English-language abstract, it appears that Yoshimitsu *et al.*'s system is non-analogous art in that it pertains to a sightseeing assistance system where sightseeing information appears to be pre-stored in memory. Further,

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it is respectfully noted that Yoshimitsu *et al.* appears to teach omitting a "last" character, rather than omitting a plurality of characters to fit data to the grid of a program display.

Regarding the VideoGuide Users Manual reference, such reference is just simply too vague to teach or suggest anything. More particularly, it is respectfully noted that the VideoGuide Users Manual is nothing more than a STRIPPED DOWN USER'S MANUAL, with absolutely no disclosure of the detailed inner workings of the VideoGuide system. Again, although the VideoGuide manual does illustrate some types of menu features, such reference never explicitly describes where/how/when these menu items are formed, *i.e.*, at best, there is only a "black box" type of disclosure. That is, the VideoGuide Users Manual teaches a user how to work the VideoGuide apparatus (**NOT HOW THE APPARATUS WORKS**). Just as it was wrong for the Examiner to speculate about how/where the Lawler *et al.* menu items were formed, it is equally as wrong for the Examiner to speculate about how/where the VideoGuide menu items are formed within the VideoGuide apparatus.

If one were to speculate, it is respectfully submitted that logical reasoning would tend to show that the VideoGuide arrangement likewise would have implemented the prevalent standard in the art to perform pre-truncating of titles **BEFORE** transmission to the receivers. More particularly, it is known within the art that the *circa* 1995-96 VideoGuide system broadcasted/received television scheduling via radio frequency (RF) transmitters operating using national pager bandwidth. That is, textual information regarding a television schedule was "paged" to the VideoGuide box. Given that pager bandwidth was an expensive and scarce

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commodity in *circa* 1995-96, it is respectfully submitted that the VideoGuide arrangement almost certainly would have pre-truncated titles BEFORE transmission to the receivers.

In any event, certainly there is no comparator or comparing process disclosed anywhere within the vague VideoGuide disclosure. In short, any attempt to characterize where/how/when the VideoGuide menu items are formed would be pure speculation, which is inappropriate/insufficient to support a §103 type rejection.

**In short**, given that **none of Lawler et al., Yoshimitsu et al., Alten et al. and Video Guide User's Manual explicitly teaches receiving program information at a receiver and then performing comparison/omission at the receiver end to obtain truncated titles for a program grid**, it is respectfully submitted that no combination of such art would have resulted in, or would have suggested, Applicant's disclosed and claimed invention. Further, in view of the low relevance of such art, and also the improper Examiner's speculation with regard to operation of such art, it is respectfully submitted that **the present rejection is nothing more than an attempt at an improper hindsight reconstruction rejection of Applicant's claimed invention**.

Regarding independent Claim 48, which has a fifth (5<sup>TH</sup>) feature/operation beyond the four discussed in Applicant's prior paper, *i.e.*, 5) a particular background information block characteristic (e.g., shape) also is changed for Applicant's extended programs, traversal of the Office Action comments is appropriate. More particularly, Applicant's independent Claim 48 recites "changes a particular background information block characteristic, when the particular background information block of the particular extended program exceeds the prescribed time

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period of the first prescribed zone in the grid." Office Action comments state, "[t]he capability of moving the JOYSTICK left or right, up or down disclosed in page 12 of VideoGuide User's Manual to change the background information block characteristic as claimed in claim 48."

**Traversal is appropriate because the Office Action comments appear to miss the point and/or mischaracterize.** More particularly, Applicant's background block characteristic is changed when the particular extended program (to which it pertains) "exceeds the prescribed time period of the first prescribed zone in the grid." For example, the block shape is changed responsive to the block exceeding a range of the grid. In contrast, the block in the VideoGuide User's Manual's, at best, is changed responsive to JOYSTICK movement (i.e., not to grid exceeding). Again, none of the applied references discloses or suggests such combination.

While the Examiner has attempted to provide a line of reasoning regarding the rejection concerning Applicant's changed background information block characteristic (e.g., shape), the undersigned (after numerous attempts) still cannot understand/follow the Examiner's explanation or reasoning. If the rejections are continued in a next Office Action, the Examiner is respectfully requested to provide a clarified and/or differing line of reasoning.

As a result of all of the foregoing, it is respectfully submitted that the applied art (taken alone and in the Office Action combinations) would not support a §103 obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of any art rejections, and express written allowance of all present claims, are respectfully requested.

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**OFFICE ACTION COMMENTS RE PUBLIC AVAILABILITY - TRAVERSED**

Office Action comments on page 2 of the Detailed Action portion of the Office Action state, "Additionally, the reference is available and can be readily accessed by the employees, who can distribute to friends and families' members, (public) of the printing company (VideoGuide, Inc.) from 1995". **Strong traversal against such comments is appropriate.** More particularly, it is respectfully submitted that the employees of VideoGuide, Inc. and employees of any printing company (which printed the VideoGuide User's Manual), almost certainly would have been subject to a confidentially or non-disclosure employment contracts, where they would NOT have freely distributed to friends and family-members. In short, it is respectfully submitted that the above-referenced Office Action comments are improper, and again, are just pure speculation on a part of the Examiner. Withdrawal of the Office Action comments are respectfully requested.

**EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area number of 703-312-6600, to discuss an Examiner's Amendments or other suggested action for accelerating prosecution and moving the present application to allowance.

**RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer. That is, any above statements, or any present amendment or cancellation of claims (all made without prejudice or

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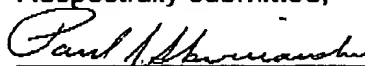
disclaimer), should not be taken as an indication or admission that any objection/rejection was valid, or as a disclaimer of any scope or subject matter. Applicant respectfully reserves all rights to file subsequent related application(s) of any type and directed to any/all limitations/features which have been subsequently amended or cancelled or have not yet been claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims presently under consideration in the application are now in condition for allowance, and early allowance of such claims is respectfully requested.

To whatever extent necessary, Applicant respectfully petitions the Commissioner for an extension under 37 CFR §1.136. A Form PTO-2038 authorizing payment of fees (including the Petition fee) may be attached. Please charge any actual deficiency in fees to ATS&K Deposit Account No. 01-2135 (referencing Case No. 500.35360CX1).

Respectfully submitted,



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